



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/640,076	08/17/2000	Thomas J. Campana JR.	780.29643CX5	4893

7590

06/02/2005

DONALD E. STOUT  
ANTONELLI, TERRY, STOUT & KRAUS, LLP  
1300 NORTH SEVENTEENTH STREET  
SUITE 1800  
ARLINGTON, VA 22209

EXAMINER

FOSTER, ROLAND G

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/640,076

Applicant(s)

CAMPANA ET AL.

Examiner

Roland G. Foster

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 94-265 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 94-265 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Detailed Action**

#### **Summary of the Written Restriction Requirement**

Claims 94-265 are directed to inventions that are independent or distinct for the following reasons.

The application effectively recites 777 claims. Specifically, the application recites five independent claims that, in turn, recite a total of 260 dependent claims. Furthermore, four of these dependent claims are multiple dependent claims that recite in the alternative 128 of the preceding dependent claims. Thus, the application effectively recites 772 dependent claims. These 772 dependent claims are drawn to a large number of varying and permuted combinations and subcombinations. Many of the subcombinations have no limitations in common other than dependence upon common linking claims (as discussed *infra*). Many of the combinations simply add a new limitation and repeat all of the subcombinations. Thus, the 772 dependent claims present extensive and facial evidence that many of the claims can be considered patentably distinct.

In addition, administrative burden exists. Beyond the obvious conclusion that examining 777 claims would be administratively burdensome, the patentably distinct claims have different classifications, fields of search, and status in the art.

A restriction requirement under the above circumstances has several benefits. The restriction requirement promotes a clear and complete prosecution history of a single, original

Art Unit: 2645

invention. The requirement promotes the quality, administrative determination of patentability for both the applicant and for the public.

### **Linking Claims**

Claims 94, 234, 242, 250, and 258 link Inventions 1-25. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s). Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Art Unit: 2645

invention. The requirement promotes the quality, administrative determination of patentability for both the applicant and for the public. For example, the applicant no doubt is aware that many of the continuing applications related to the present application similarly recited a large number of claims, were examined without restriction, and are now undergoing various *inter-partes* and *ex-parte* reexamination proceedings.

### **Linking Claims**

Claims 94, 234, 242, 250, and 258 link Inventions 1-25. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s). Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

### **Description of the Separate Inventions**

Restriction to one of the following inventions is required under 35 U.S.C. 121.

Invention 1 (subcombination): claims 95, 96, 100-105, 108-111, 118-129, 131, 132, 136-141, 144-147, 154-157, 150, 160, 164-169, 172-175, 182-193, 195, 196, 200-205, 208-211, 218, 219, 235-240, 245-248, 253-256, and 261-264, drawn to a system for originating electronic mail wherein the intended recipient is identified by the name of the recipient.

Invention 2 (subcombination): claims 97-99, 112-117, 133-135, 148-153, 161-163, 176-117, 197-199, 212-217, 235, 243, 251, and 259, drawn to a system for originating electronic mail wherein the system deletes information from the information contained in the electronic mail and such deleted information is not transmitted by the wireless system.

Invention 3 (subcombination): claims 106-111, 142-147, 170-175, and 206-211, drawn to a system for originating electronic mail wherein after reception of the electronic mail, a processor adds additional information which is transmitted to a wireless system.

Invention 4 (subcombination): claims 130-132 and 194-196, drawn to a system for originating electronic mail wherein a wireless network processor determines a destination in the wireless system.

Art Unit: 2645

Invention 5 (subcombination): claims 158-160, 220-222, 244, 249, and 260, drawn to a system for originating electronic mail wherein a check is performed by a network processor in the system to determine if the information in the electronic mail should be transmitted by the wireless system.

Inventions 6-10 (combinations): claims 223, 225, 227, and 230. Claim 223 is a multiple dependent claim. All of the Inventions 6-10 recite a common system for originating electronic mail wherein at least one wireless device also originates electronic mail by executing electronic mail programming. In addition, each of the Inventions 6-10 individually recites the details from Inventions 1-5 respectively. Thus, Invention 6 is a combination to the subcombination of Invention 1; Invention 7 is a combination to the subcombination of Invention 2, etc.

Inventions 11-15 (combinations): claims 224 and 228. Claim 224 is a multiple dependent claim. All of the Inventions 11-15 recite a common system for originating electronic mail wherein at least one additional network processor originates additional information without executing electronic mail programming. In addition, each of the Inventions 11-15 individually recites the details from Inventions 1-5 respectively. Thus, Invention 11 is a combination to the subcombination of Invention 1; Invention 12 is a combination to the subcombination of Invention 2, etc.

Inventions 16-20 (combinations): claims 226, 241, 257, 265, 240, 257, and 265. Claim 226 is a multiple dependent claim. All of the Inventions 16-20 recite a common system for

Art Unit: 2645

originating electronic mail wherein at least one wireless device receiving the electronic mail is in another system that receives electronic mail. In addition, each of the Inventions 16-20 individually recites the details from Inventions 1-5 respectively. Thus, Invention 16 is a combination to the subcombination of Invention 1; Invention 17 is a combination to the subcombination of Invention 2, etc.

Inventions 21-25 (combinations): claim 231. Claim 231 is a multiple dependent claim. All of the Inventions 21-25 recite a common system for originating electronic mail wherein at least one wireless device receiving the electronic mails executes an electronic mail program. In addition, each of the Inventions 21-25 individually recites the details from Inventions 1-5 respectively. Thus, Invention 21 is a combination to the subcombination of Invention 1; Invention 22 is a combination to the subcombination of Invention 2, etc.

## **Patentable Distinctness**

### **The Subcombinations Are Patentably Distinct From Each Other**

Inventions 1-5 are related as subcombinations disclosed as usable together in a single system where originating processors originate electronic mail for conditional transmission to a wireless device.

Subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention 1 has separate utility as a system that can originate email to a recipient identified by name, which has in the wireless portion of the system for determining the



Art Unit: 2645

destination wireless device from the name of the intended recipient. Invention 2 has separate utility has a system that can delete information from an email before transmitting the email to a wireless system, which has use for omitting extraneous or incompatible information during wireless transmission. Invention 3 has separate utility as a system that can add information to information in a received email before transmitting all the information to the wireless system, which has use in containing the email with header/footer (i.e. container) information that is compatible with the wireless system (where the email's original container format may have been incompatible with a wireless system). Invention 4 has separate utility as a system that automatically determines the wireless address of a device corresponding to the intended recipient of an email, which has use in automatically routing email from an email system to a wireless system. Invention 5 has separate utility as a system that allows discretionary control over whether information in the email should be transmitted to wireless system, which has use in situations where the information in the email is not suitable for limited bandwidth wireless transmission (e.g., large attached file). See MPEP § 806.05(d).

All the Combinations Corresponding to One Subcombination Are Patentably Distinct over the  
Combinations Corresponding to the Remaining Subcombinations

As discussed above in the Description of Related Inventions, Inventions 6-25 are related as combinations disclosed as usable together in a single system where originating processors originate electronic mail for conditional transmission to a wireless device.

Art Unit: 2645

Certain groups of combinations have the same patentably distinguishing features as the corresponding subcombinations, as discussed above (see the Description of Separate Inventions) and below:

<u>Combinations</u> (Each invention listed below is a different combination)	<u>Corresponding Subcombination</u>
Inventions 6, 11, 16, and 21	→ Invention 1
Inventions 7, 12, 17, and 22	→ Invention 2
Inventions 8, 13, 18, and 23	→ Invention 3
Inventions 9, 14, 19, and 24	→ Invention 4
Inventions 10, 15, 20, and 25	→ Invention 5

Also as discussed above, each of the five subcombinations (Inventions 1-5) patentably distinguish from each other because each subcombination has a separately usable feature. The corresponding combinations have the same separately usable feature. In addition, the combinations can be viewed as subcombinations to the overall systems for originating email to and from a wireless system. Subcombinations are distinct from each other if they are shown to be separately usable (as discussed above). Therefore, all of the combinations corresponding to one subcombination (e.g., Inventions 6, 11, 16, and 21) are patentably distinct over the combinations corresponding to the remaining subcombinations. For example, Invention 6 (combination) distinguishes over Inventions (combinations) 7-10, 12-15, 17-20, and 22-25 for the same reasons that Invention 1 (subcombination) distinguishes over Inventions (subcombinations) 2-5.

The Combinations Corresponding to One Subcombination Are Also Patentably Distinct From  
Each Other

As discussed above, the Inventions (combinations) 6-25 can be viewed also as subcombinations to the overall system for originating email to and from a wireless system. Subcombinations are distinct from each other if they are shown to be separately usable. The combinations corresponding to each subcombination are also patentably distinct from each other. For example, Inventions 6-10 have separate utility as a system that can originate email from a wireless device by executing electronic mail programming, which has use in advanced wireless devices with native email clients the ability to send email as normal. Inventions 11-15 have separate utility as a system that can originate email from a wireless device without executing electronic mail programming, which has use in allowing users of devices without any native email support (e.g., old pager or cellular telephones) to send email. Inventions 16-20 have separate utility as a system where the wireless device receives email in another system that receives email, which has use in allowing the user to receive email from plural email systems. Inventions 21-25 have separate utility as a system that can receive email at the wireless device by executing electronic mail programming, which has use in allowing users of devices with native email clients the ability to receive email as normal. See MPEP § 806.05(d).

The Combinations Are Patentably Distinct from Their Corresponding Subcombinations

As discussed above in the Description of Related Inventions, Inventions 1-25 are related as combination and subcombination as follows:

<u>Combinations</u> (Each invention below is a different combination)	<u>Corresponding Subcombination</u>
Inventions 6, 11, 16, and 21	→ Invention 1
Inventions 7, 12, 17, and 22	→ Invention 2
Inventions 8, 13, 18, and 23	→ Invention 3
Inventions 9, 14, 19, and 24	→ Invention 4
Inventions 10, 15, 20, and 25	→ Invention 5

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, each combination as claimed does not require the particulars of the corresponding subcombination as claimed because each limitation in the subcombinations that distinguish over the corresponding subcombinations is separately claimed, thus providing evidence that the combination does not require the particulars of the subcombination for patentability. For example, the combination of Invention 24 (claim 231 depending from claims 130-132 and 194-196) distinguishes over Invention 4 (claims 130-132 and 194-196) in that Invention 24 recites at least one wireless device receives the electronic mail by executing electronic mail programming. However, the additional feature was separately recited (claim 231

Art Unit: 2645

depending from claim 94) (when the generic linking claim 94 has been removed). Thus, the combination of Invention 24 does not require the particulars of the subcombination of Invention 4.

Each of the subcombination has separate utility. For example, the combination of Invention 24 (claim 231 depending from claims 130-132 and 194-196) recites the additional feature that a wireless device receives the electronic mail by executing an electronic mail programming. Thus, the subcombination of Invention 4 would have separate utility as a system for originating electronic mail where the wireless device can receive electronic mail by executing something other than electronic mail programming, such as by a paging process capable of transferring electronic mail.

### **Administrative Burden**

As discussed above, the instant application effectively recites 777 claims drawn to 25 patentably distinct Inventions. Under such circumstances alone, administrative burden obviously exists. Nonetheless, additional showings of administrative burden can be presented because the Inventions have separate classification in the art, separate status, and/or a different field of search.

### **Separate Classification and Different Field of Search**

Inventions 1-25 have separate classifications and fields of search as discussed below.

Art Unit: 2645

Invention 1 includes classification in class 711, subclass 202, electrical computer address conversion and translation. The field of search for Invention 1 would concentrate on systems that alias the address of an intended recipient to the name of an intended recipient.

Invention 2 includes classification in class 370, subclass 466, multiplex communications converting between communication protocols. The field of search for Invention 2 would concentrate on system that transmit between network protocols (e.g., gateway systems), where certain information in one communication protocol may have to be deleted because that information is incompatible or not suited to the destination protocol. The field of search for Invention 2 would also include transmitting multimedia messages (e.g., video, text, and audio) to a destination system (e.g., pager) that does not support all the media formats, in which case certain media (e.g., video) may have to be deleted.

Invention 3 includes classification in class 455, subclass 414.4, 515, wireless telephone paging and signaling. Invention 3 also includes classification in class 340, subclass 10.52, paging system addressing format using an identification code. The field of search for Invention 3 would include wireless systems able to add wireless addressing information to received email from external networks (e.g., the Internet).

Invention 4 includes classification in class 709, subclass 206, demand based messaging (email). Note that Invention 4 can include the services of an email program in contrast to Inventions 11-15, which are similar to Invention 4 except that they specifically exclude the use

Art Unit: 2645

of an email program. The field of search for Invention 4 would include wireless system addressing techniques and wireless systems with integrated email programs running at the server level.

Invention 5 includes classification in class 455, subclass 419, wireless telephone remote programming control. The field of search for Invention 5 would include wireless systems that allow the user to screen incoming messages by content (e.g., preventing messages from certain users).

Inventions 6-10 include classification in class 455, subclass 466, wireless telephone auxiliary data signaling (e.g., SMS), which can be used for originated email messages. Inventions 6-10 also include classification in class 340, subclass 7.31, paging system message input. Inventions 6-10 also include classification in Inventions 1-5 respectively (i.e., same as the corresponding combinations as discussed above). The field of search of for Inventions 6-10 would include techniques to originate email messages at wireless terminals using standard email clients (i.e., email programming).

Inventions 11-15 include classification in class 455, subclass 445, wireless telephone call routing (which would include systems that don't execute email programs). Invention 4 also includes classification in class 340, subclass 10.31, paging system call (which also include systems that don't execute email programs). Inventions 11-15 also include classification in Inventions 1-5 respectively (i.e., same as the corresponding combinations as discussed above).

Art Unit: 2645

The field of search for Inventions 11-15 would include techniques to originate and route email at the server level in a wireless system by relying on standard messaging techniques (e.g., paging and call routing) without the use of standard email programming.

Inventions 16-20 include classification in class 340, subclass 7.29, paging system ("another system") connected to the Internet. Inventions 16-20 also include classification in Inventions 1-5 respectively (i.e., same as the corresponding combinations as discussed above). The field of search for Inventions 16-20 would include systems that can receive email from multiple email systems.

Inventions 21-25 include classification in class 709, subclass 203, computer client/server systems, where the receiving device executing the electronic mail would typically run a client email program. Inventions 21-25 also include classification in Inventions 1-5 respectively (i.e., same as the corresponding combinations as discussed above). The field of search for Inventions 21-25 would include wireless terminals that run typical email clients (i.e., email programming).

#### Separate Status in the Art

A separate field of search (as discussed above) also shows a separate status in the art (MPEP § 808.02). Thus, Inventions 1-25 also have separate status in the art.



Art Unit: 2645

Conclusion – Administrative Burden

Because these Inventions are drawn to 25 different Inventions and 777 claims, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification for the reasons given above, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for one Invention is not required for the other Inventions for the reasons given above, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter for the reasons given above, restriction for examination purposes as indicated is proper.

**Requirement for a Complete Response**

Applicant is advised that the reply to this requirement to be complete must include an election of one of the Inventions 1-25 to be examined even if the requirement is traversed (37 CFR 1.143).

Art Unit: 2645

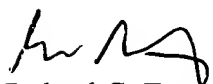
### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland G. Foster whose telephone number is (571) 272-7538.

The examiner can normally be reached on Mon to Fri from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roland G. Foster  
Primary Patent Examiner  
May 27, 2005